



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,422	07/02/2001	Hiroaki Shinohara	50R4615	1895

7590 03/14/2006
John L. Rogitz
Rogitz & Associates
Suite 3120
750 B Street
San Diego, CA 92101

EXAMINER

SHIBRU, HELEN

ART UNIT PAPER NUMBER

2616

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,422

Applicant(s)

SHINOHARA, HIROAKI

Examiner

Helen Shibru

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-13,15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-13,15 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Response to Amendment

1. The amendment filed on 12/13/05 is entered. The objection to the drawings is withdrawn.

Response to Arguments

2. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 7, 9-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of whoever.

Mankovitz discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in the present claims 1, and 9-10, including the feature of the player including media stored content including text information (See the capability of playing both stored video information and program guide information where the program guide information would include text information such as the title of the program as shown in Mankovitz's Figure 7), the feature of the TV communicating with the player (See the capability of displaying the video information on a display apparatus

as disclosed in Mankovitz), and the feature of the personal video recorder including a processor accessing a database to record at least one broadcast program based at least partially on a viewer-selected portion of the text as specified in the present claims 1, and 9-10. (See the capability of performing schedule recording of broadcasted programs in the recorder based on user selection of specific programs information from the displayed program guide information as shown in Mankovitz's column 10, lines 40-51).

Although Mankovitz discloses the capability of playing media content stored on a recording medium, Mankovitz however, fails to disclose the feature of the player as being a DVD player as specified in the present claims 1, and 9-10.

Examiner takes Official Notice in that it is notoriously well known in the video recording/reproducing art to have a DVD player connected with a TV for the purpose of playing and displaying media content retrieved from disk recording medium as specified in the present claims 1 and 9-10.

It would have been obvious to one skilled in the art to modify the Mankovitz's apparatus wherein the player provided thereof (See Mankovitz's Figure 1, component 40) would be replaced by a DVD in a manner to record and reproduce media content on and from the medium provided thereof in the same conventional manner as is well known in the prior art. Examiner has taken Official Notice. The motivation is increase the recording density of the recording medium as suggested in the prior art.

With regard to claim 3, the feature of the input device manipulate to establish the selected portion as specified thereof is present in the proposed combination of

Mankovitz and Official Notice indicated above. (See Mankovitz's Figure 1, component 75).

With regard to claim 7, it is noted that all the feature recited thereof are present in the proposed combination of Mankovitz and Official Notice indicated above, including the feature of the program information being audio and video program information as specified thereof. (See the capability of receiving television program data in Mankovitz's Figure 1, components 64, 63, wherein such television program information would be inherently include video and audio data).

With regard to claim 8, the feature of storing the viewer selection to at least one viewing history stored in the PVR as specified thereof would be inherently present in the proposed combination indicated above. Because, the Mankovitz's apparatus would forcedly include the capability of storing in the recording means provided thereof the viewer's selection of video programs (EPG) so as to be able to set up the schedule recording operation in the Mankovitz's recording system.

5. Claims 5-6, and 11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz and Official as applied to claim 1 above, and further in view of Killian.

The proposed combination of Mankovitz and Official Notice indicated above does disclose a recording/reproducing apparatus that shows substantially the same limitations recited in the present claims 5-6, and 11, including the feature of receiving broadcasted program information from a database (in this proposed combination the database is interpreted as the broadcasting station itself) and recording the same on a recording means based on viewer selected portion of text information such as a EPG as

Art Unit: 2616

specified in this present claims 5-6, and 11. (See the above rejection of claim 1, particularly the capability of performing schedule recording based on viewer selected portion of text information such as a EPG).

The proposed combination of Mankovitz and Official Notice indicated above fails to specifically disclose the feature of updating said database with information available on a WAN as specified in the present claims 5-6, and 11.

Killian discloses a video recording/reproducing apparatus including said feature of updating said database with information available on a WAN. (See Killian's Figure 1, where it is disclosed the capability of updating database information through the Internet).

It would have been obvious to one skilled in the art to modify the proposed combination indicated above wherein the database (Broadcasting station) can be updated through the internet in the same conventional manner as shown by Killian. The motivation is to be able to provide most recent program information to the viewer at any desired time as suggested by Killian.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Killian.

Killian discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 12-13, including the feature of linking content to viewing and or shopping recommendations and the feature of automatically accessing a source of recommended viewing and/or shopping based on viewer's selection of characters data that are part of a DVD content as specified in the present claims 12-13. (See Killian's Figure 3, and column 10, line 61, to column 11, line 21, and column 7, lines 33-48).

With regard to claim 15, the feature of selecting is a user input device as specified thereof is present in Killian. (See Killian's Figure 1, component 42, and column 4, lines 55-64, and column 9, lines 36-42).

With regard to claim 17, the feature of the recorder as specified thereof is shown in Killian's Figure 1, component 26).

With regard to claim 18, the feature of the source of recommended viewing and/or shopping communicates with a WAN as specified thereof is present in Killian. (See Killian's Figure 1, component 14).

With regard to claim 19, the feature of playing media stored content on a storage medium and sending the same to a television as specified thereof is present in Killian. (See Killian's Figure 1, components 20, 26, and 40).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Shibru whose telephone number is 571-272-7329. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H. Shibru
March 6, 2006.



Robert Chahal